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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/461,375 12/15/99 GUERET

J 2350-76

EXAMINER

HM12/0705

NIXON & VANDERHYE PC
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ARLINGTON VA 22201-4714

CHOICE	
ART UNIT	PAPER NUMBER

1616
DATE MAILED:

07/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/461,375

Applicant(s)

GUERET, JEAN-LOUIS

Examiner

Frank I Choi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 15, 17, drawn to a colorless solution for cosmetic use and a patch or device containing the same.
- II. Claims 10-14, drawn to a method of preparing a device for instantaneous cleansing and care of the skin.
- III. Claim 16, drawn to a cosmetic method of cleansing the skin.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, for example, mixing a filler and/or essential oil and keratolytic agent in an organic solvent, adding one or more self-adhesive hydrophobic polymers, and optionally incorporating said solution into a patch.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different

process of using that product such as applying the product as a skin mask without the need of a support.

Because these inventions are distinct for the reasons given above and the search required for Groups I-III are not required for each other. Group II requires the search of specific patch structures not required of Groups I or III, Group III requires the search of a specific method of application not required of Groups I, II, as such, restriction for examination purposes as indicated is proper. In light of the above, prosecution of all groups appear to constitute an undue burden on Examiner.

During a telephone conversation with B. J. Sadoff on 5/4/00 a provisional election was made with traverse to prosecute the invention of Group I, claim 1-9, 15, 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-14, 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-9 are rejected under 35 U.S.C. 102(e) or 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Slavtcheff.

Slavtcheff expressly discloses compositions containing PVA, alcohol, salicylic acid, and oils falling within the scope of applicant's claims (Columns 7, 8, Table I).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978).

Claims 1-9, 15, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slavtcheff et al. in view of Lehmann et al.

Slavtcheff et al. teach a clear skin care product containing keratolytic agents, oils, thickeners, alcohol and an adhesive containing polyvinyl alcohol and acrylate polymers which can be applied by pad (Column 1, lines 50-68, Columns 2-4, Column 5, lines 1-27).

Lehmann et al. teach carrier foils which adhere to the skin and are removable containing adhesives, alcohol, keratolytic substances and fillers in the form of powders (Columns 3, 4, Column 5, lines 5-47). It is taught that the formulations allow a controlled release of drug to the skin and are easy to manufacture (Column 5, lines 39-47).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose a colorless solution containing in combination an organic solvent, at least one self-adhesive hydrophobic polymer, at least one filler and/or essential oil, at least one

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keratolytic agent, wherein the polymer has an adhesiveness of between 150 and 800 g/ square centimeter after evaporation of said organic solvent. However, the prior art amply suggests the same as it is known in the art to prepare clear solutions containing keratolytic agents, fillers/oils, self-adhesive hydrophobic polymers which may be incorporated into a patch. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation of preparing a formulation which allows controlled release of drug to the skin and is easy to manufacture.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

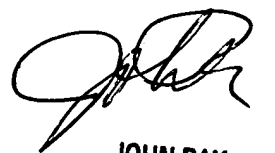
A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

FIC

July 3, 2000



JOHN PAK
PRIMARY EXAMINER
GROUP 1200

